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3. REMARKS / DISCUSSION OF ISSUES

Claims 1-4, 6-11, 13, 15-20 are under present consideration. Claims 1 and 10 are independent claims.

Unless indicated otherwise, claims are amended for non-statutory reasons: to correct one or more informalities, remove figure label number(s), and/or to replace European-style claim phraseology with American-style claim language.

I. Objections to the Drawings

In the Office Action Summary, there is no clear indication of the status of the drawings. The undersigned attorney will remind the assignee of the need for formal drawings to be filed, if not done so already.

II. Objections to the Specification

In the Office Action Summary, the specification is indicated as being objected to. However, there is no articulated objection in the substantive portion of the Office Action. Clarification is requested.

III. Objections to the Claims

The objection to 20 has been addressed and is moot in view of the present amendment.

IV. Indication of Withdrawn Claims

The Office Action Summary indicates that claims 5, 12 and 14 are withdrawn from consideration. Claims 5, 12 and 14 are cancelled. Clarification is requested.

At page 2, the Office Action indicates that claims 6-9 are not being prosecuted on their merits because of their dependence on a cancelled base claim. The dependence of these claims has been addressed in the present Response.

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V. Rejections under 35 U.S.C. § 102

Claims 10, 13 and 15-17 are rejected under one of 35 U.S.C. § 102(a) as being anticipated by *Vilppula, et al.* (U.S. Patent Publication 2002/0019698 A1). For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn.

A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). (Emphasis added in each instance.)

Claim 10 is drawn to a mobile equipment and features:

"...at least two drivers for said position determination devices, each driver being capable of storing and retrieving at least one parameter associated with the position determination device. . ."

The Office Action turns to paragraphs [0048] and [0050] of the reference to *Vilppula, et al.* for the drivers as claimed. A review of these paragraphs does not reveal the disclosure of the drivers of claim 10. Paragraphs [0048] and [0050] disclose parameters describing the quality of the positioning data. A positioning method selection device (PMSD) can obtain the parameters describing the quality of the positioning data at intervals or by monitoring the situation. However, there is no disclosure in the noted portions of the reference of at least

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two drivers or of the **positioning devices**. Rather, a PMSD is disclosed that retrieves parameters of the quality of data provided by a positioning method.

Furthermore, Applicants respectfully submit that the Examiner has not clearly articulated a rejection within the tenets of MPEP § 706. The onus lies initially on the Office to articulate any rejections of the claims under examination. For example, the rejection does not recite with clarity that which the Examiner regards as the drivers or the positioning devices of claim 10. This requires Applicants to infer that which may be the driver or the positioning devices. As such, Applicants respectfully submit that a clearly articulated rejection has not been provided, and for at least this reason, the rejection is improper.

For at least the reasons set forth above, Applicants respectfully submit that each and every element of the claim 10 is not disclosed in the reference to *Vilppula, et al.* and thus there is at least one difference between claim 10 and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Thus, a *prima facie* case of anticipation has not been established and claim 10 and the claims that depend therefrom are patentable over the applied art.

VI. Rejections under 35 U.S.C. § 103

1. Claims 1-4 are rejected under one of 35 U.S.C. § 103(a) as being unpatentable over *Vilppula, et al.*, *Roel-Ng, et al.* (U.S. Patent 6,002,936) and *Borkoski, et al.* (U.S. Reissue Patent 38,267). For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn.

Analysis of obviousness under 35 U.S.C. § 103 requires determination of the scope and content of the prior art, the differences between the prior art, and the claims at issue, and the level of ordinary skill in the pertinent art.

W.L. Gore & Associates, Inc. v. Garlock, Inc. 220 USPQ 303, 311 (1983) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (CAFC 1966)). Moreover, there must have been something present in the teachings of the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W.L. Gore & Associates* at 311 (citing

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In re Bergel 130 USPQ 206, 208 (CCPA 1961); and *In re Spinnoble* 160 USPO 237, 244 (CCPA 1969)).

Furthermore, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is a reason, suggestion or motivation do so. The reason, suggestion or motivation may come from references themselves; from knowledge of those skilled in art that certain references or disclosures in references are known to be of interest in the particular field; or from nature of the problem to be solved to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.* 37 USPQ2d 1626 (CAFC 1996). Moreover, prior knowledge in the field must be supported by tangible teachings of reference materials. *Cardiac Pacemakers Inc. v. St. Jude Medical Inc.* 72 USPQ 2d 1333, 1336 (CAFC 2004).

However, hindsight is never an appropriate motivation for combining references and/or the requisite knowledge available to one having ordinary skill in the art. To this end, relying upon hindsight knowledge of applicants' disclosure when the prior art does not teach nor suggest such knowledge results in the use of the invention as a template for its own reconstruction. This is wholly improper in the determination of patentability. *Sensonics Inc. v. Aerosonics Corp.*, 38 USPQ 2d 1551-1554 (CAFC 1996), citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303. Moreover, the determination of obviousness cannot be based on the hindsight combination of components selectively culled out from the prior art to fit the parameters of the claims at issue. *Crown Operations International Ltd. v. Solutia Inc.* 62 USPQ2d 1917, 1922 (CAFC 2002).

Applicants submit that the applied art lacks the disclosure of at least one of the features of claim 1. Claim 1 is drawn to a method for generating position information in a mobile equipment provided with at least two position determination devices and features:

"...determining whether a currently active position determination device supplies data according to [a position data] format, and,

- in the negative, converting the position data supplied by the currently active position determination device into the requested position data format."

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The Office Action turns to the reference to *Borkoski, et al.* for the teaching of the noted features of claim 1. In particular, the Office Action asserts that converting the position data supplied by the currently active position determination device into the requested position data format is disclosed in the Abstract; column 1, lines 40-46; column 2, lines 45-47; and column 9, lines 14-16 of the reference. Assuming arguendo that this is the case, Applicants note that this step is preceded 'in the negative'; meaning if determining whether a currently active position determination device supplies data according to a position data format is not the case, then converting the position is undertaken. Therefore, because the Office Action fails to address the disclosure in the applied art of at least one feature of claim 1, the rejection is improper and should be withdrawn.

The above notwithstanding, in the noted portions *Borkoski, et al.* discloses a method of determining the location of a wireless station originating communications within a cell site and includes acquiring and translating network identification data for a mobile station. At column 9, the reference discloses receiving data and performing conversions to provide a uniform output message to applications. However, this differs from the feature of claim 1 noted above. In particular, the method of claim 1 includes first determining whether a currently active position determination device supplies data according to a position data format, and, then, if necessary, converting the position data supplied by the currently active position determination device into the requested position data format. By contrast, *Borkoski, et al.* teaches merely a translation and lacks at least the claimed comparison. Furthermore, the portions of the reference relied upon merely disclose the receiving data and providing a uniform output message to applications. There is no disclosure that the data are from a position determining device or that the data is position data.

Applicants also respectfully traverse the combination of references as being improper. Respectfully, Applicants submit that the present rejection is cobbled from the teachings of multiple references using the rejected claims as templates for their own reconstruction. To wit, the rejection garners certain elements of the claims under examination from one reference, some from a second and some from a third reference without providing evidence of

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motivation to do so. For example, the Office Action alleges that the combination of *Borkowski, et al.* with *Vilppula, et al.* and *Roel-Ng, et al.* would have been obvious to successfully determine the position of a terminal. However, the Office Action provides no support from the references to *Vilppula, et al.* or *Roel-Ng, et al.* that it was suggested to do so. Accordingly, Applicants respectfully submit that for at least the reasons provided, the requisite motivation to combine references is lacking in the present rejection.

For at least the reasons set forth above, Applicants respectfully submit that the rejection of claim 1 and the claims that depend therefrom is improper and should be withdrawn.

2. Claims 11 and 18-20 were rejected based on combinations of *Vilppula, et al.* and *Roel-Ng, et al.*; and *Vilppula, et al.* and *Borkowski, et al.*, respectively. These claims depend from independent claim 10 initially or ultimately. As such, these claims are patentable over the applied art at least because of their dependence on claim 10. While in no way conceding the propriety of this rejection, Applicants respectfully submit that these claims are patentable over the applied art. Moreover, Applicants reserve their right to traverse this rejection in subsequent replies.

V. Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

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Respectfully submitted,



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